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First Named Inventor Wayne Cohen

Art Unit 3723

Examiner Name Shantese L. McDonald

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ENCLOSURES (Check all that apply)

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Firm Name	Dorsey & Whitney, L.L.P.		
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Printed name	Gary Abelev, Esq.		
Date	February 17, 2006	Reg. No.	Reg. No. 40,479

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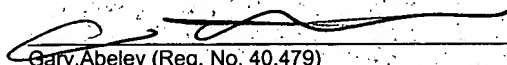


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s) : Wayne COHEN
Serial No. : 10/796,446
Filed : March 9, 2004
For: BOTTLE OPENER
Examiner: James G. Smith
Art Unit: 3723

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February 17, 2005


Gary Abelev (Reg. No. 40,479)

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REINSTATEMENT OF APPEAL UNDER 37 C.F.R. § 1.193(b)(ii)(2)

Appellant hereby requests a reinstatement of the appeal under 37 C.F.R. § 1.193(b)(ii)(2) filed on July 20, 2005 along with the previously submitted Appeal Brief.

In particular, on November 1, 2004, the U.S. Patent and Trademark Office (the "Patent Office") received a Notice of Appeal from the final rejection of claims 26 and 27 contained in the Final Office Action issued by the U.S. Patent and Trademark Office (the "Patent Office") on July 28, 2004 in the above-identified patent application, and objection to the claim of priority to from U.S. Patent Application Serial No. 09/865,349 filed on May 25, 2001, and issued as U.S. Patent No. 6,775,869 on August 17, 2004. Along with the Appeal Brief Appellant filed an Amendment after Final Office Action including the requested language in the specification to refer to such priority application. Upon entry on this Amendment after Final Office Action, the Examiner re-opened prosecution of this

application, and again rejected claim 26 and 27 in the Office Action dated November 17, 2004.

In accordance with 37 C.F.R. § 1.192(b)(3)(ii), Applicant hereby submits the accompanying Supplemental Brief is in triplicate in support of the reinstated appeal of the final rejection of pending claims 26 and 27.

Reversal of the Examiner's rejections of the claims is respectfully requested as set forth in the Supplement Appeal Brief.

Respectfully submitted,

Dated: February 17, 2006

By 

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s) :	Wayne COHEN	<u>On Appeal to the Board of Appeals and Interferences</u>
Serial No. :	10/796,446	Examiner: Shantese L. McDonald
Filed :	March 9, 2004	Art Unit: 3723
For :	BOTTLE OPENER	

SUPPLEMENTAL BRIEF ON APPEAL

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STATUTE(S)

35 U.S.C. § 103(a)	Passim
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s) :	Wayne COHEN	<u>On Appeal to the Board of Appeals and Interferences</u>
Serial No. :	10/796,446	Examiner: Shantese L. McDonald
Filed :	March 9, 2004	Art Unit: 3723
For :	BOTTLE OPENER	

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL BRIEF ON APPEAL

November 1, 2004, the U.S. Patent and Trademark Office (the "Patent Office") received a Notice of Appeal from the final rejection of claims 26 and 27 contained in the Final Office Action issued by the U.S. Patent and Trademark Office (the "Patent Office") on July 28, 2004 in the above-identified patent application, and objection to the claim of priority to from U.S. Patent Application Serial No. 09/865,349 filed on May 25, 2001, and issued as U.S. Patent No. 6,775,869 on August 17, 2004. Along with the Appeal Brief, Appellant filed an Amendment after Final Office Action including the requested language in the specification to refer to such priority application. Upon entry on this Amendment after Final Office Action, the Examiner re-opened prosecution of this application, and again rejected claim 26 and 27 in the Office Action dated November 17, 2004.

In accordance with 37 C.F.R. §§ 1.192(a) and 1.193(b)(2)(ii), this supplemental brief is submitted in triplicate in support of the appeal of the additional

rejection of pending claims 26 and 27. For at least the reasons set forth below, the rejection of pending claims 26 and 27 should be reversed.

I. REAL PARTY IN INTEREST

The real party in interest of the present application is the inventor, Wayne Cohen.

II. RELATED APPEALS AND INTERFERENCES

Appellant and the Appellant's legal representatives are unaware of any appeals or interferences related to the present application which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

After the prosecution of the present application was re-opened following the filing of the original Appeal Brief, claims 26 and 27 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,056,464 issued to Cohen (the "Cohen Patent"), in view of U.S. Patent No. 5,169,305 issued to Kee (the "Kee Patent").

Appellant appeals from the rejection of pending claims 26 and 27. A copy of all of the pending claims is attached hereto in the Appendix.

IV. STATUS OF AMENDMENTS

Subsequent to the issuance of the Office Action dated November 17, 2005, no further amendment have been filed by Appellant.

V. SUMMARY OF INVENTION

Generally, the invention described in the above-identified application is directed to a bottle opener and a maraca 10. (See Appellant's Specification, e.g., p. 2, paras. [0004] and [0005]). The maraca 10 includes a shell 12 which encloses pellets 14 for providing a rattle-type sound. The maraca 10 includes a handle 16 which is generally cylindrical, and has a tapered shape including a wide portion for gripping by the hand of a user. The wide portion of cylindrical handle 16 is provided with a transverse groove 18 formed therein. The groove 18 includes a bottom grooved surface 24, a first side surface 26 and a second side surface 22. A metal tool 20 is mounted within groove 18, and arranged to engage the edge of a bottle cap for opening a bottle. (See *id.*, pp. 4-5, para. [0019]).

The metal tool 20 is mounted within the groove 18 of the cylindrical handle 16. The metal tool 20 includes a first web portion 32, a second web portion 34, a third web portion 36, and a fourth web portion 38. The fourth web portion 38 of the metal tool 20 is driven into a slot 44 formed in the cylindrical handle 16. The slot 44 is substantially perpendicular to the central axis 28. The fourth web portion 38 of the metal tool 20 is inserted into the slot 44 until the first web portion 32 comes in contact with an under cut 24A of the surface 24. The undercut 24A is formed in surface 24 to accommodate the cooperation with the metal tool 20. A portion 40 of the fourth web portion 38 may be pressed out to form a tooth for engaging the interior of slot 44, and to retain the metal tool 20 therein. (See *id.*, p. 5, para. [0022]).

VI. ISSUE(S) ON APPEAL

The issue on appeal are as follows:

Whether the Examiner failed to establish a *prima facie* case that claims 26 and 27, which stand rejected under 35 U.S.C. § 103(a), are unpatentable over the Cohen Patent in view of the Kee Patent.

VII. GROUPING OF CLAIMS

Issue: Group - all pending claims 26 and 27.

VIII. ARGUMENTS

1. Prior Art relied on by the Examiner

The Examiner relies on the Cohen and Kee Patents for maintaining the rejection of claim 26 and 27 as being unpatentable over the Cohen Patent, in view of the Keep Patent.

The Cohen Patent relates to a novelty attachment 10 for a pen or pencil 12, which is formed as a hollow shell 14 with sounding beads therein. The attachment is provided in the form of a maraca without a handle, and when attached to a pen or pencil may be shaken to produce a maraca rattle sound. (See Cohen Patent, Abstract; and col. 1, Ins. 59-62).

The Kee Patent relates a gas-lighter with an opener which is also fit to remove tabs of tin cans, and includes a perfume chamber to emit a fragrance. (See Kee Patent, col. 1, Ins. 24-30). As provided in the Kee Patent, the opener includes an opener section 3 which has a shape that is similar to the shape of an opener piece 4, as

well as a screw groove 10. The screw groove 10, with a screw driven therein, is used for fixing the opener piece 4 to the opener section 3. (See *id.*, column 2, Ins. 25-29). The opener piece 4 has a catch 4a which, in operation, catches beneath the underside edge of a bottle cap. (See *id.*, col. 2, Ins. 30-33).

2. Relevant Statutory Law, Case Law and Procedure(s)

Non-Obviousness in view of 35 U.S.C. §103(a)

"To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Indeed, to sustain a rejection under 35 U.S.C. § 103(a), there must be some teaching, other than the instant application, to alter the prior art to arrive at the claimed invention. "The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. From this, the Examiner must provide a positive reason why it would be

obvious to modify the prior art to arrive at the claimed invention. Absent an explanation of “the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [applicant’s] invention to make the combination, [there is an inference] that the examiner selected these references with the assistance of hindsight,” which is clearly impermissible. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). A positive suggestion or motivation to alter the prior art is a requisite safeguard against hindsight being used to negate patentability. *Id.* at 1459.

“Multiple cited prior art references *must suggest the desirability* of being combined and the reference must be viewed without the benefit of *hindsight* afforded to the disclosure. *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994); *emphasis added*. “It is improper to use the inventor’s disclosure as a road map for selecting and combining prior art disclosures.” See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on Appellant’s disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When combining references for purposes of demonstrating obviousness of the claimed invention, the first requirement is that a suggestion, teaching, or motivation to combine the prior art references be shown. *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing is an “essential evidentiary component of an obviousness holding.” *Id.*, emphasis added. This evidence may flow from the (1) prior art references themselves, (2) the knowledge of

one of ordinary skill in the art, or, in some cases, (3) from the nature of the problem to be solved. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000), *citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). "This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *Brown & Williamson Tobacco Corp.* emphasis added.

3. Issue on Appeal

Group – Claims 26 and 27

Appellant respectfully asserts that there is absolutely no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kee Patent to teach or suggest Appellant's invention, as recited in independent claim 26, and claim 27 which depends from this independent claim 26, for the following reasons.

Independent claim 26 relates to a maraca which comprises, *inter alia*,

a maraca body;

a maraca handle connected to the maraca body; and

a bottle cap opener connected to the maraca handle.

In the Office Action dated January 17, 2003, the Examiner admits that the Cohen Patent does not show "the use of a bottle cap opener of the combination tool." (See Office Action dated January 17, 2003, p. 2, last four

lines). However, the Examiner alleges that "[i]t would therefore be obvious to one skilled in the art at the time the invention was made to modify any of the Cohen by using a bottle cap opener instead of second tools or devices because Kee suggest[s] the use of such a bottle opener in combination type tools." (See *id.*, p. 2, last line to p. 3, lines 2-5). In the Office Action dated November 17, 2006, the Examiner contends that "the Kee reference teaches combining a bottle opener with another device." (Office Action dated November 17, 2005, p. 2, lines 17-18).

Contrary to the Examiner's belief, Appellant respectfully submits that **there is no teaching, suggestion, incentive or motivation to combine** the teachings of the Kee Patent with those of the Cohen Patent to teach or suggest *the assembly of a bottle cap opener connected to a maraca handle*, which is connected to a maraca body, as explicitly recited in independent claim 26. The Examiner is respectfully reminded that "[m]ultiple cited prior art references must suggest the desirability of being combined and the reference must be viewed without the benefit of hindsight afforded to the disclosure." (emphasis added) *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994), emphasis added. "The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998). Appellant respectfully submit that *there is no motivation or incentive to combine* the Kee Patent with the Cohen Patent to allegedly form Appellant's claimed invention.

In particular, one of the objects of the present invention is to "provide a bottle opener which may, for example, be incorporated into the handle of another item, such as a maraca." (See Appellant's Substitute Specification, e.g., page 2, paragraph [0003], as amended). However, the Cohen Patent provides "a new novelty attachment for a pencil or pen that include a hollow shell with sounding beads which, when attached to a pen or pencil can act as a maraca or rattle." (See Cohen Patent, column 1, lines 6-9). Thus, the problem confronted by the inventor for the above-identified application is completely different than the problem confronted by the inventor in the Cohen Patent (i.e., the same inventor). Indeed, the Cohen Patent nowhere mentions that the pen or pencil can include any type of an opener, much less a bottle cap opener as recited in independent claim 72. Therefore, there is no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kee Patent to teach or suggest Appellant's claimed invention as recited in independent claims 26.

Appellant further submits that "[i]t is improper to use the inventor's disclosure as a road map for selecting and combining prior art disclosures." See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). "[T]he reference must be viewed without the benefit of hindsight afforded to the disclosure." *In re Paulsen*, *supra*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not be based on Appellant's disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Appellant respectfully submits that the Examiner is relying on an **improper hindsight reconstruction**, which cannot be used for rejecting the claims of the above-identified application.

Accordingly, Appellant respectfully asserts that there is no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kee Patent to teach or suggest Appellant's invention as recited in independent claim 26, in the manner contemplated by the Examiner. Because claim 27 depends from claim 26, respectively, it is respectfully asserted that this dependent claim is allowable for at least the same reasons.

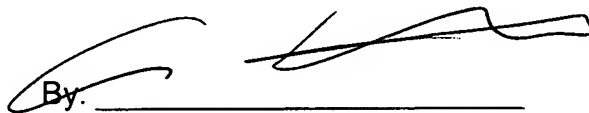
Accordingly, without the ability to combine the Cohen Patent with the Kee Patent, the resultant combination (if any) fails to teach or suggest the subject matter recited in claims 26 and 27. Therefore, Appellant respectfully requests the Board to reverse the Examiner's § 103(a) rejection of claims 26 and 27.

IX. CONCLUSION

For at least the reasons indicated above, Appellant respectfully submits that the invention recited in the presently rejected claims of the present application, as discussed above, is new, non-obvious and useful. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

Dated: February 17, 2006


By. _____

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APPENDIX

Claims as currently pending:

26. A maraca comprising:

a maraca body;

a maraca handle connected to the maraca body; and

a bottle cap opener connected to the maraca handle.

27. The maraca of claim 26, wherein the bottle cap opener is incorporated into the maraca handle.

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